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APPLICATION NUMBER 08/894,136	FILING DATE 08/10/97	FIRST NAMED APPLICANT BRUCHMANN	ATTY. DOCKET NO. 524-2769-U
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IM12/0702

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EXAMINER

SERGEANT, R

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 7/02/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-9 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1711

15. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear what group is represented by the language, "C₅ aryl", since aryl groups possess a six carbon ring. See page 3 of the specification and claim 1. Do applicants intend that a C₅ group be attached to an aryl group?

16. It is noted that applicants refer to isocyanates having up to 30 carbon atoms at line 42 of page 3 of the specification; however, applicants' claim 2 specifies no more than 20 carbon atoms for the isocyanate.

17. Claims 4 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The statement within claim 4 that the mixture contains water, including up to 80 mole percent of water is ambiguous. Water is stated as being a component in addition to water.

18. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 2 of claims 6 and 7, "are" should be "is".

Claim Rejections - 35 U.S.C. § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1711

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mohring et al. ('350 or '936) in view of Wagner et al. ('127 or '622) and Hennig et al. ('956).

Mohring et al. disclose the production of biuret containing polyisocyanates having a low unreacted polyisocyanate monomer content and light color, wherein diisocyanates are reacted with an alcohol component, including tertiary alcohols; an amine component; and water. See column 3, lines 10+ and columns 4-7.

21. While Mohring et al. disclose the use of amines, patentees fail to disclose the use of applicants' claimed amine containing stabilizer. However, applicants' claimed stabilizers were known at the time of invention to be useful agents for the production of biurets. See column 6, lines 8+; column 9, lines 9+; and column 11, lines 55+, within Wagner et al. See column 1, lines 53+ and column 2 within Hennig et al. Furthermore, Hennig et al. disclose that their biurets, derived from urea derivatives, are light in color. See examples.

22. Therefore, one of ordinary skill in the art would have been motivated to utilize the amine containing biuretizing agents of the secondary references in place of the amine component of Mohring et al., because one would have reasonably expected the amine compounds of the primary

Art Unit: 1711

and secondary references to function as equivalents. It has been held that it is *prima facie* obvious to substitute an equivalent component for another, where equivalency is known within the art. *In re Ruff*, 118 USPQ 343 (CCPA 1958). Furthermore, it has been held that it is *prima facie* obvious to combine components, known to be useful for the same purpose, to yield a third component to be used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069. Therefore, the position is further taken that it would have been obvious to combine known biuretizing agents, such as tert-butanol and urea or formamide, for example, as disclosed by Wagner et al., to yield a biuretizing composition suitable for producing a biuret.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982

R. Sergent:cb
Patent Examiner


RABON SERGENT
PRIMARY EXAMINER

June 30, 1998